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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL CHAD HOLLIS and CRAIG ALLEN CARROLL

Appeal 2009-003088
Application 10/717,536
Technology Center 3700

Decided: January 13, 2010

Before JENNIFER D. BAHR, LINDA E. HORNER, and
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael Chad Hollis and Craig Allen Carroll (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the Examiner's decision rejecting claims 1-5, 29-31, and 52-54. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention is a bevel angle locking actuator and system for locking a compound miter saw at a desired bevel angle. Spec. 1, para. 0002. Claims 1 and 54, reproduced below, are representative of the subject matter on appeal.

1. A saw comprising:

a base assembly with a top surface;

a fence assembly mounted to the base assembly with a front surface positioned above the top surface of the base assembly, the front surface of the fence assembly and the top surface of the base assembly cooperating to support a workpiece thereon;

a saw support assembly rotatably mounted to the base assembly to rotate relative to the base assembly about a first rotational axis;

a saw unit having a saw blade capable of turning to cut a workpiece, the saw blade defining a cutting plane that is approximately parallel to the first rotational axis, the saw unit supported by the saw support assembly above the top surface so

that the saw blade is capable of being moved relative to the base assembly by a user into a workpiece resting on the top surface of the base assembly to make a cut, the saw unit and the saw support assembly rotating together about the first rotational axis to adjust the bevel angle of the saw blade; and

a bevel angle locking actuator mounted to the saw support assembly, wherein the bevel angle locking actuator rotates in unison with the saw support assembly about the first rotational axis when the bevel angle of the saw blade is adjusted, and wherein the bevel angle is capable of being adjusted by a user when the bevel angle locking actuator is in an unlocked position and the bevel angle cannot be adjusted by a user when the bevel angle locking actuator is in a locked position.

54. A saw comprising:

a base assembly;

a saw unit having a saw blade;

a saw support assembly rotatably mounted to the base assembly, the saw support assembly supporting the saw unit and pivoting the saw unit to plunge the saw blade into a workpiece resting on the base assembly, the saw support assembly rotating relative to the base assembly about a first rotational axis to adjust the bevel angle of the saw blade;

a bevel locking linkage which translates in a direction normal to the first rotational axis, the translation of the bevel locking linkage causing the saw support assembly to be pushed against the base assembly creating friction which prevents relative rotation.

THE REJECTIONS

Appellants seek review of the following rejections:

1. The Examiner rejected claims 1-5, 29, 31, and 52-54 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,021,700, issued February 8, 2000 to Garuglieri.
2. The Examiner rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Garuglieri and Applicants' Admitted Prior Art (AAPA).

ISSUES

Appellants presented arguments rebutting the anticipation rejection of claims 1-5, 29, 31, 52, and 53 as a group. App. Br. 3-5. We select claim 1 as representative of the group, and the remaining claims of the group will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009). Appellants separately argued the patentability of independent claim 54. App. Br. 5-6.

The Examiner construed the claim language "mounted to," as recited in independent claim 1, to encompass the indirect mounting of a bevel locking actuator to a saw support assembly, as disclosed in Garuglieri. Ans. 5-6. The Examiner construed the claim language "translates," as recited in independent claim 54, to encompass rotation of a bevel locking linkage to change the linkage from one state to another. Ans. 6.

Appellants contend the Examiner's claim constructions are unreasonably broad in view of the ordinary meaning of these claim terms and in view of Appellants' Specification. App. Br. 4-5; Reply Br. 2-5.

Appellants further contend that since the AAPA relied on in the § 103 rejection of dependent claim 30 does not cure the deficiencies of Garuglieri with respect to claim 1, dependent claim 30 is allowable for the same reasons as claim 1. App. Br. 6. As such, our determination of patentability of claim 30 under § 103 turns on our determination of patentability of claim 1.

The issues presented by this appeal are:

Have Appellants shown the Examiner erred in finding that Garuglieri discloses a bevel angle locking actuator “mounted to” the saw support assembly?

Have Appellants shown the Examiner erred in finding that Garuglieri discloses “a bevel locking linkage which translates in a direction normal to the first rotational axis”

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellants’ Specification describes the mounting of the bevel angle actuator 290 to the saw support assembly 200 as follows:

The bevel angle locking actuator 290 is mounted to the saw support assembly 200 so that the bevel angle locking actuator 290 rotates in unison with the saw support assembly about the first rotational axis when the bevel angle is adjusted. Positioning the bevel angle actuator

290 on the saw support assembly 200 presents several advantages over previous designs where the bevel angle locking actuator was mounted at the rear of the saw. The bevel angle locking actuator 290 is more easily accessible to the operator of the saw when mounted to the saw support assembly 200. When the bevel angle locking actuator was mounted at the rear of a compound miter saw, reaching around to lock the bevel angle sometimes required extreme manipulations of the operator's wrist and arm.

Spec. 9-10, para. 0028.

2. The illustrative embodiment of Appellants' invention shown in figures 1-6 depicts the bevel angle actuator 290 mounted directly to the saw support assembly 200 without any intermediary, connecting, or anchoring pieces or components.
3. Appellants' Specification describes generally:

It should be understood that the principles of the invention are capable of being practiced in other embodiments dissimilar in certain respects to the illustrated embodiments depicted in the drawing figures. The illustrative embodiments will be used to teach the principles of the invention, but the scope of the invention is not intended to be limited to the illustrative embodiments. In particular, it should be understood that the illustrative bevel locking actuator may be used with a bevel locking system different from the one shown in the drawing figures, and *vice et versa*.

Spec. 5, para. 0017.

4. Appellants' Specification describes that the bevel locking linkage 230 slides "almost in a straight line" (normal to the longitudinal

- axis of bolt 260) to cause it to be wedged between cam surfaces formed on a trunnion insert. Spec. 11-12, paras. 0032, 0033; fig. 6.
5. The ordinary meaning of “translate” in the mechanical sense is: “[t]o subject (a body) to translation.” *The American Heritage Dictionary* 1287, 2nd college ed. (1982) (definition 7 *Physics*).
 6. The ordinary meaning of “translation” is “[m]otion of a body in which every point of the body moves parallel to and the same distance as every other point of the body; nonrotational displacement.” *The American Heritage Dictionary* 1287, 2nd college ed. (1982) (definition 3 *Physics*).

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written

description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

It is the appellants’ burden to precisely define the invention, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.”).

ANALYSIS

“Mounted to”

The Examiner provided a dictionary definition of “mounted” as “to attach to a support.” Ans. 5 (quoting *Merriam-Webster Online Dictionary* (definition v. 6a.)).¹ The Examiner then found that Garuglieri’s handle 172

¹ Appellants provided a similar dictionary definition of “mounted” as “to fix securely to a support: *mount an engine to a car.*” App. Br. 4 (quoting *The American Heritage Dictionary of the English Language, Fourth Edition* (2005)).

(a bevel angle actuator) is attached to a link pin 66, and the link pin 66 joins a guide support 62 to a pivot member 26 (which is the claimed saw support assembly). Thus, the Examiner concluded that Garuglieri's bevel angle actuator 172 is "indirectly mounted to" the saw support assembly 26.

Ans. 5-6.

Appellants do not contest the Examiner's findings that:

- (1) Garuglieri's handle meets the claimed bevel angle actuator;
- (2) Garuglieri's pivot support 26 meets the claimed saw support assembly,
- or (3) Garuglieri's handle is mounted indirectly to the pivot support.

Rather, Appellants argue that in view of the description of the invention provided in Appellants' Specification, the claim language "mounted to" should not be interpreted to encompass indirect mounting of Garuglieri's bevel angle actuator to its saw support assembly. Reply Br. 3-4.

First, neither the ordinary meaning of "mounted" proffered by the Examiner nor the definition proffered by Appellants specifies whether the attachment or securement to the support is direct or indirect. Thus, the ordinary meaning alone is broad enough to encompass indirect securement to a support, and the Examiner's construction of "mounted" is not inconsistent with the ordinary meaning of the word.

Second, Appellant's Specification does not necessitate a narrower meaning of the term "mounted." Appellants' Specification describes that the bevel angle actuator 290 is "mounted to" the saw support assembly 200 so that bevel angle locking actuator 290 rotates in unison with the saw support assembly about the first rotational axis when the bevel angle is adjusted

(Fact 1). This description uses the same “mounted to” language as the claim, without specifying that the actuator must be mounted directly, rather than indirectly, to the saw support assembly. The rotation of these portions of the saw in unison can be accomplished by direct or indirect mounting, so the remainder of this description likewise does not provide specifics on the type of mounting to be used.

Appellants argue that the use of the word “on” to describe the position of the bevel angle actuator 290 “on” the saw support assembly 200 supports interpretation of “mounted to” as calling for a direct mount (Reply Br. 3) (Fact 1). This portion of Appellants’ Specification is contrasting positioning of the bevel angle actuator 290 on the saw support assembly 200 as opposed to the prior art positioning of the bevel angle actuator at the rear of the saw. The advantages noted in Appellants’ Specification by the positioning of the bevel angle actuator 290 would be achieved regardless of whether the bevel angle actuator is mounted directly to the saw support assembly or whether the bevel angle actuator is mounted indirectly to the saw support assembly via an intermediate member. As such, this portion of Appellants’ Specification does not appear to require the actuator to be mounted directly to the saw support assembly in order to achieve the advantages of Appellants’ invention, and thus this description appears to also encompass the actuator being “on” the assembly via an intermediate member.

While figures 1-6 of Appellants’ Specification show the bevel angle actuator 290 mounted directly to the saw support assembly 200 without any intermediary, connecting, or anchoring pieces or components (Fact 2),

Appellants' Specification makes clear that the claimed invention is not limited to the embodiment shown in these figures (Fact 3). As such, we do not see a reason to read the particular illustrative embodiment shown in figures 1-6 into claim 1 when the claim language is broader than this illustrated embodiment. As such, we affirm the Examiner's interpretation of "mounted to" in claim 1 to encompass the indirect mounting of Garuglieri's handle 172 (bevel angle actuator) to pivot support 26 (saw support assembly) via pivot pin 66. We affirm the Examiner's anticipation rejection of claim 1, and claims 2-5, 29, 31, 52, and 53 falling with claim 1. Further, based on the same analysis provided *supra* for claim 1, Appellants have failed to show the Examiner erred in rejecting claim 30 under § 103.

"Translates"

The Examiner provided a definition of "translate" as "changing from one place, state, form, or appearance to another." Ans. 6 (citing *Merriam-Webster Online Dictionary* (definition v. 1a)). The Examiner found that Garuglieri's handle 172 translates "since the element 172 changes from a state of unlocking position to a state of locking position in a direction normal to the first rotational axis." Ans. 6 (annotated drawing).

Appellants argue the Examiner erred in finding that Garuglieri's handle 172 translates because "[t]hroughout the specification, the bevel locking linkage [230 of Appellants' invention] is described as moving 'almost in a straight line motion in a direction approximately normal to the longitudinal axis of bolt 260.'" Reply Br. 5. Appellants argue that their definition of "translates" to exclude rotation is consistent with the ordinary

meaning of “translate,” which means “to change the position of (a body or figure) in space without rotation.” Reply Br. 5 (citing *Webster’s Third New Int’l. Dict.* 2429 (1993)).

Appellants’ Specification describes that the bevel locking linkage 230 slides “almost in a straight line” (normal to the longitudinal axis of bolt 260) to cause it to be wedged between cam surfaces formed on a trunnion insert (Fact 4). This description is consistent with the ordinary mechanical meaning of “translate” to mean non-rotational displacement (Facts 5, 6). In view of the description of the bevel locking linkage provided in Appellants’ Specification, we conclude that “translates,” as called for in claim 54, means displacement without rotation.

Because Garuglieri’s handle 172 rotates from a locked position to an unlocked position, as depicted on page 6 of the Examiner’s Answer, handle 172 does not translate in a direction normal to the first rotational axis, as called for in claim 54. As such, we cannot sustain the rejection of claim 54 under § 102(b).

CONCLUSIONS

Appellants have failed to show the Examiner erred in finding that Garuglieri discloses a bevel angle locking actuator “mounted to” the saw support assembly.

Appellants have shown the Examiner erred in finding that Garuglieri discloses “a bevel locking linkage which translates in a direction normal to the first rotational axis.”

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DECISION

The decision of the Examiner to reject claims 1-5 and 29-31 is
AFFIRMED. The decision of the Examiner to reject claim 54 is
REVERSED.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
§ 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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